

REMARKS

Remarks to follow are numbered to correspond to the office action.

5

Election/Restrictions

1,2. Applicant acknowledges the restriction and election.

Claim Rejections - 35 USC § 102

3,4. Examiner rejects claims 1, 7, 8 and 11 as being anticipated
10 by Thennes under 35 USC 102 (e).

As amended, claim 1 now contains a new clause reciting:
"said outer side surface further comprising an outer diameter
thereof which, between said outer lower section diameter and an
outer upper section diameter thereof, *substantially never*
15 *increases when moving from any lower circumference thereof to any*
higher circumference thereof, from all side cross-sections." It
is clear from applicant's figures and description that
applicant's invention may be so-characterized.

This clearly does not read on, and is not anticipated by
20 Thennes, because Thennes clearly shows a region above the stem
and continuing upward to the midsection of the glass, wherein
there is a pronounced, very substantial *increase* in diameter when
moving from any lower circumference thereof to any higher
circumference thereof.

25 This difference is quite important, because as one learns
from elementary mechanics, a lower center of gravity provides
more stability than a higher center of gravity. In applicant's

device, see especially the side view of Figure 1, the substantially never-increasing circumference of applicant's apparatus when moving from any lower circumference to any higher circumference ensures that when the apparatus is filled with a
5 fluid, the center of gravity will always reside below the midpoint of the height of the apparatus. (The wider base through which the line illustrating 109 runs, also ensures a center of gravity below the height midpoint even when the apparatus is unfilled.)

10 In contrast, the configuration of Thinnes serves to raise the center of gravity, which reduces the stability of Thinnes' device. First, the very narrow fillet (stem) 140 raises the height of container 110, and thereby, raises the center of gravity of the entire apparatus more than would occur absent the
15 stem. Second, the very shape of the container 110 in Thinnes raises the center of gravity, in particular, because the lower portion of 110 below where the arrow from 112 meets up with 110 is progressively-narrower as one moves downward toward the stem at 140. This is precisely the opposite of the configuration
20 required to produce a lower center of gravity. If one's objective is strictly stability, then the container 110 in Thinnes should instead resemble applicant's Figure 1, perhaps placed atop the stem. But, it clearly does not resemble applicant's Figure 1.

25 Of course, Thinnes's objective goes beyond simply ensuring the stability of the wine glass. The configuration of applicant's Figure 1 would present a very different aesthetic and

wine-sipping functionality than what is expected were it to be enlarged and then employed for a wine glass. Specifically, there is, in Thinnes, also the aesthetic consideration of maintaining a stem (which also has the functional purpose of being a point of contact for a human hand so that heat is not transferred from hand to the wine), and also, Thinnes' glass needs to have "an interior surface 112 that is shaped to present the bouquet of a particular type of wine." (Thinnes, starting at the third line of paragraph 45.) These considerations force a raising of the center of gravity higher than would be required if the only objective were to provide a stable, non-spill vessel for holding antiseptic solutions during surgical procedures, such as applicant's invention.

The added recitation in claim 1, wherein the diameter of applicant's apparatus "substantially never increases when moving from any lower circumference thereof to any higher circumference thereof" distinguishes past not only the visual appearance of Thinnes, but provides the inherent functional benefit of a definitively lower center of gravity. With this, comes an enhancement of stability, which is a key objective of applicant's invention. This enhanced stability provides a degree of stability greater than does Thinnes which must also concern itself with the aesthetic and functional objectives of wine drinking and thereby raise the center of gravity to accommodate these further objectives.

As such, the rejection of claim 1 based on Thinnes is overcome. Because claims 7, 8 and 11 depend on claim 1 as

amended, these claims are similarly not anticipated by Thinnes.

5,6. Examiner rejects claims 1, 7, 11, 25 and 26 as being anticipated by Slonim under 35 USC 102 (b).

5 Examiner completely misinterprets and mischaracterizes the apparatus in Slonim referenced as numeral **14**. This apparatus is described in Slonim three different times, as follows:

10 In column 3, lines 60 through: "FIG. 1 shows a bottom portion **24**, with compartments holding . . . sterile ophthalmic antibiotic solution **13**, sterile ophthalmic antibiotic ointment **14**, . . ."

15 In column 4, lines 3 through 16: "However, in the preferred embodiment, emergency eye kit invention **2** contains . . . at least one resealable *flexible bottle* of sterile ophthalmic antibiotic solution **13**; at least one 3.5 gm. *flexible tube* of sterile ophthalmic antibiotic ointment **14**. . ."

20 In column 4, lines 42 through 46: "FIG. 4 shows removable top tray **30** filled with . . . sterile ophthalmic antibiotic solution **13**, sterile ophthalmic antibiotic ointment **14** . . ."

25 Key points to be noted from the above, and from Slonim's drawings, are as follows: 1) apparatus **14** in Slonim contains an "ointment" as opposed to a "solution." 2) Slonim was clearly intending to describe the contents of **14** as an "ointment" not a "solution," which is underscored by the fact that element **13** was said to contain a "solution," and, by way of contrast, that **13** and **14** were each said to hold something which is a "sterile ophthalmic antibiotic." In the former case of **13**, this is a

"solution," in the latter case of **14**, it is an "ointment." 4)
From column 4, lines 3 through 16 specifically, element **13** is a
"flexible bottle" of the aforementioned "solution", while element
14 is a "flexible tube" of the aforementioned "ointment." 5) If
one takes a careful look at element **14** in Figures 1 and 4, there
is very clearly a second line running near and parallel to the
bottom line of **14**, and in contrast that there is no such line in
13. This buttresses the written description of element **14** as a
flexible tube of ointment. The parallel lines at the bottom of
14 represent the bottom portion of any flexible tube through
which, during the manufacturing process, is open so that the
ointment can be inserted unto the flexible tube, and which is
then folded and more-permanently adhered closed before commercial
distribution of the flexible tube of ointment. And, an
"ointment," as opposed to a "fluid" or a "solution," is
understood in the art to refer to a viscous, semisolid solution,
for which the spillage to be avoided by applicant's invention is
not a pertinent question. For example, some web-definitions of
"ointment" include the following: From www.answers.com: "A
20 highly viscous or semisolid substance used on the skin. . ."
From en.wikipedia.org: "a viscous semisolid preparation used
topically on a variety of body surfaces." From www.google.com:
"semisolid preparation (usually containing a medicine) applied
externally . . ."
25 All of the foregoing makes it clear that examiner has
completely mischaracterized the apparatus in Slonim referenced as
14 when he states that **14** is "a conventional apparatus utilized

to hold an antiseptic solution." Examiner further mischaracterizes **14** when he states that "it is known that the apparatus will have an open top in order to remove or add fluid to the apparatus," and that "it is an anti-spill, anti-splash 5 apparatus."

Apparatus **14** is simply a flexible tube of ointment, no more, no less. From the frontal view that is shown in Slonim, **14** happens to be wider toward the bottom than toward the top, and it happens to be part of an emergency eye-care kit, but that is 10 where the similarity with applicant's apparatus ends. There is no way, for example, that one can stand a flexible tube of ointment such as **14** upright on its end in the same way that applicant's Figure 1 can clearly be stood upright on a horizontal surface. There is no way to "add fluid" to a flexible tube of 15 ointment as examiner has imagined. One squeezes the flexible tube to emit ointment, the inner volume of the flexible tube then contracts, and this is a one-way process. (There is even an adage about not being able to put "toothpaste back into the tube.") Finally, the wider bottom section shown in Slonim is 20 only a view from one side. Because **14** is a flexible tube of ointment, when viewed from the side 90 degrees removed, it most certainly will not present the same profile, and in particular, it will not present a wider profile toward its bottom when viewed 25 from all side cross-sections. From 90 degrees removed, and from all angles except the angle illustrated in Slonim and the angle 180 degrees removed (i.e., except from two side cross sections), apparatus **14** will have the same cross-section of any other

flexible tube of ointment, which is not wider at the bottom, and which is not at all like the cross section of applicant's invention.

Consequently, to avoid any possible misinterpretation of the 5 flexible ointment tube in Slonim as being related in any substantial manner to applicant's invention, claim 1 is further amended to specify that the recitations of claim 1 apply "from more than two side cross-sections." This clearly is not the case with flexible ointment tube 14 in Slonim, which aside from its 10 different appearance when viewed from angles other than that shown in Slonim's drawings and an angle 180 degree removed therefrom, serves a completely different function that cannot in any way be analogized to applicant's invention. It is, plainly speaking, just what Slonim says it is: a *flexible tube of* 15 *ointment*. Examiner is completely mistaken in trying to liken this to applicant's invention.

As such, the rejection of claim 1 based on Slonim is overcome. Because claims 7, 11, 25 and 26 depend on claim 1 as amended, these claims are similarly not anticipated by Slonim.

20

Claim Rejections - 35 USC § 103

7-10. Because all rejections of independent claim 1 based on Thinnies and Slonim have already been overcome, and because all of the 103 rejections are of dependent claims, these claims are now 25 allowable, based at least upon their dependency on claim 1. Nevertheless, applicant does wish to make a few further remarks.

In a number of situations, examiner concludes his rejection

of a claim or claims by stating "only the expected results would be obtained." However, this may not be the case. For example, examiner states in rejecting claims 12 and 13 that "only the expected results would be obtained" for a fluid holding volume of 5 37.5 cubic centimeters. However, as stated by applicant in the original disclosure, reproduced in paragraph 28 of applicant's pre-grant publication US 2004-0011695, "it would be especially difficult to drink from a shot-sized glass with these characteristics, because as noted, a 25 to 50 cubic centimeter 10 glass would have a relatively small diameter in the range of 3 to 6 centimeters. Especially if this diameter were to narrow toward its top, such a 25 to 50 cubic centimeter glass, given its tight radius of curvature, would be quite awkward to effectively drink from, because the drinker's lips could not make proper contact 15 with the top rim and in all likelihood the beverage being consumed would be prone to spill, and the drinker's nose would butt up against the region of the top rim opposite the drinker's lips and require use drinker to tilt his or her face significantly upward in order to the point of discomfort in order 20 to compete successful drinking." Rendering a wine glass incapable of being used as a wine glass is more than "only the expected results."

Additionally, as discussed earlier, many of the changes which examiner states could occur such that "only the expected 25 results would be obtained," would in fact serve to move the center of gravity of the apparatus upward or downward, and thereby alter the stability of the apparatus. This is also more

than "only the expected results."

As regards all of the rejections in points 9 and 10, and especially of claims 26 and 29, examiner has not established that element **14** of Slonim is in any way an anti-spill, anti-splash 5 apparatus in the manner of applicant's invention. It is simply a flexible tube of ointment which happens to have a particular shape from one cross-sectional view that seems to have caught examiner's attention. Examiner's rejection here seems to boil down to "I found a flexible ointment tube, which, as a flexible 10 ointment tube, really has a totally different function from applicant's invention. But, from one particular view, it has some visual similarity to applicant's device because of its wide base, and it also happens to be part of an emergency eye care kit. Therefore, it would have been obvious to someone of 15 ordinary skill in the art to assemble a surgical kit including applicant's device."

However, the foundation for this rejection simply does not stand up, because what examiner found in the eye care kit is a simple flexible tube of ointment, and no more. There is nothing 20 in Slonim that in any way discloses or suggests using this flexible tube of ointment in the manner of applicant's invention, and in fact, it would be impossible to use a flexible tube of ointment in the manner of applicant's invention, because an ointment tube is structured totally differently from applicant's 25 invention. Further, there is nothing in Thinnies which in any way suggest using the wine glass in an eye care kit, or any other medically-related kit. And, nobody of ordinary skill in any art

area would seriously think to include a wine glass in a medical kit. In short, there is nothing in either reference to suggest or justify their combination.

5

Conclusion

For the foregoing reasons, all rejections of record have now been overcome. Applicant looks forward to a notice of allowance in the near future. As noted earlier, if these amendments and remarks do not place this application into condition for 10 allowance, applicants' counsel hereby respectfully requests a telephone interview with examiner Kevin Joyner, following receipt of this reply, and prior to issuance of any further office action.

Respectfully submitted,



Jay R. Yablon, Registration # 30604
910 Northumberland Drive
Schenectady, New York 12309-2814
Telephone / Fax: (518) 377-6737
Email: jyablon@nycap.rr.com